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Filing date: **08/09/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Sazerac Company, Inc.		
Entity	Corporation	Citizenship	Louisiana
Address	3850 N. Causeway Blvd., Suite 1695 Metairie, LA 70002 UNITED STATES		

Attorney information	Lori F Mayall Cooley LLP 1299 Pennsylvania Ave., NW, Suite 700 Washington, DC 20004 UNITED STATES trademarks@cooley.com, lmayall@cooley.com Phone:650-843-5130
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Registration Subject to Cancellation

Registration No	4133092	Registration date	04/24/2012
Registrant	Intercontinental Packaging Co. 1999 Shepard Road St. Paul, MN 55116 UNITED STATES		

Goods/Services Subject to Cancellation

Class 033. First Use: 2011/06/01 First Use In Commerce: 2011/09/01 All goods and services in the class are cancelled, namely: Alcoholic beverages except beers

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	4149865	Application Date	10/03/2011
Registration Date	05/29/2012	Foreign Priority Date	NONE
Word Mark	BARBAROSSA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1997/07/00 First Use In Commerce: 1997/07/00 Rum		

Attachments	Petition to Cancel BABAROSA.pdf(71598 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/lfm/
Name	Lori F Mayall
Date	08/09/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Registration:

Registration No.: 4,133,092
Registered: April 24, 2012
Registrant: Intercontinental Packaging Co.
Mark: BABAROSA

Sazerac Company, Inc.)	
)	
Petitioner,)	
)	Cancellation No.
v.)	
)	
Intercontinental Packaging Co.,)	
)	
Registrant.)	
_____)	

PETITION FOR CANCELLATION

Sazerac Company, Inc., a Louisiana corporation having its principal place of business at 3850 N. Causeway Blvd., Suite 1695, Metairie, Louisiana 70002 (hereinafter “Petitioner” or “Sazerac”), believes that it will be damaged by the continued registration of the mark shown in Registration No. 4,133,092 registered on April 24, 2012 for BABAROSA for “alcoholic beverage except beers,” (“Registrant’s Mark”) in the United States Patent and Trademark Office (hereinafter “USPTO”) by Intercontinental Packaging Co. (hereinafter “Registrant”), and hereby petitions to cancel same under Section 14 of the Trademark Act of 1947, 15 U.S.C. § 1064.

As grounds for this Petition, Petitioner alleges that:

1. Petitioner is a Louisiana corporation, having its principal place of business at 3850 N. Causeway Blvd., Suite 1695, Metairie, Louisiana 70002.

2. On information and belief, Registrant is a Minnesota corporation, currently located at 1999 Shepard Road, St. Paul, Minnesota 55116.

3. Petitioner has marketed and sold alcoholic beverages and distilled spirits in the United States for over a century. Petitioner's premier spirits include, among others, whiskeys, vodkas, rums, and liqueurs.

4. Petitioner owns U.S. Reg. No. 4,149,865 [BARBAROSSA] for rum (hereafter "BARBAROSSA Mark").

5. Petitioner and its predecessor-in-interest have consistently and continually distilled, marketed, sold or otherwise distributed rum under the BARBAROSSA trademark since 1997. By virtue of Petitioner's efforts, and the efforts of its predecessor-in-interest, and by virtue of the excellence of its products, the public has come to know, rely on, and recognize the BARBAROSSA Mark as a source identifier for Sazerac's rum. Sazerac and its predecessor-in-interest have gained valuable reputation and a substantial amount of goodwill in the distilled spirits and rum markets through the use and recognition of its BARBAROSSA Mark.

6. Registration No. 4,133,092 was issued on April 24, 2012 to Registrant for the mark BABAROSA for "alcoholic beverages except beer" in International Class 033.

7. Registrant filed an application for the BABAROSA mark on May 4, 2011.

8. Petitioner only recently became aware of Registrant's registration and use of the BABAROSA mark.

9. Petitioner and its predecessor-in-interest have consistently and continually used the BARBAROSSA Mark in interstate commerce at least as early as July 1997 — over thirteen years prior to Registrant's application date, and Registrant's alleged first use date of the BABAROSA Mark in interstate commerce.

10. As set forth in detail below, on information and belief, Registration No. 4,133,092 is likely to be confused with and mistaken for Petitioner's alcoholic beverages (except beer) marketed and distributed with and in connection with its BABAROSA Mark. Petitioner believes that it is and will continue to be damaged by the continued registration of Registration No. 4,133,092.

CLAIM FOR RELIEF

**REGISTRATION NO. 4,113,092 SHOULD BE CANCELLED BECAUSE IT IS
CONFUSINGLY SIMILAR TO PETITIONER'S BARBAROSSA TRADEMARK.**

11. Petitioner incorporates by reference Paragraphs 1 through 10, inclusively, as if fully set forth herein.

12. Registrant's BABAROSA Mark so resembles Petitioner's BARBAROSSA Mark in appearance, sound, meaning, and commercial impression.

13. The goods covered by Registrant's Mark, namely, alcoholic beverages except beer are identical to the goods marketed and sold by Petitioner under its BARBAROSSA Mark.

14. Registrant's customer base overlaps with Petitioner's customers, namely, purchasers and consumers of alcoholic beverages.

15. As Registrant's goods description contains no restrictions or limitations as to Registrant's channels of trade, Petitioner may assume that Registrant's BABAROSA mark, like Petitioner's own BARBAROSSA Mark, has been used, and will continue to be used, in all accepted channels of trade. Thus, in addition to overlapping consumer bases, Registrant's channels of trade for its alcoholic beverages overlap with the channels of trade used by Petitioner in marketing, selling, and otherwise distributing its alcoholic beverages under the BARBAROSSA Mark.

16. On information and belief, Petitioner asserts that Registrant's alcoholic beverages

are marketed, sold and distributed under the BABAROSA mark via liquor stores, and via the Internet.

17. Consumers familiar with Petitioner's rum marketed and sold under the BARBAROSSA Mark will likely perceive Registrant's products as associated, affiliated with, or sponsored by Petitioner. Such confusion will inevitably result in damage to Petitioner. Accordingly, Petitioner believes it is, and will continue to be, harmed by the continued registration of the mark shown in Registration No. 4,113,092.

18. Petitioner's customers and the relevant public are likely to misapprehend Registrant's Mark as a mark of Petitioner rather than a mark of Registrant and/or believe in error that the alcoholic beverages offered under the Registrant's BABAROSA mark are offered by, in association with, or under license from Petitioner.

19. Any defect, objection to or fault found with Registrant's alcoholic beverages marketed under its BABAROSA mark will necessarily reflect on and injure the reputation that Petitioner has established for its alcoholic beverage and distilled spirits products.

20. For the foregoing reasons, the similarity between Registrant's BABAROSA mark and Petitioner's BARBAROSSA Mark is likely to cause consumer confusion resulting in damage and injury to Petitioner.

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WHEREFORE, Petitioner requests that the present Petition for Cancellation be sustained and Registration No. 4,113,092 be cancelled.

Respectfully submitted,

COOLEY LLP

Date: August 9, 2012

By: 

Lori F. Mayall, Esq.

Todd S. Bontemps, Esq.

Attorney for Petitioner

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Washington, DC 20004

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CERTIFICATE OF SERVICE

I hereby certify that on August 9, 2013, I mailed the foregoing **PETITION FOR CANCELLATION** regarding Sazerac Company, Inc. v. Intercontinental Packaging by depositing a true and correct copy of the same with the United States Postal Service, postage prepaid, in an envelope addressed to the owner of record:

Intercontinental Packaging Co.
Attn: Legal Department
1999 Shepard Road
St. Paul, MN 55116

Date: August 9, 2013



Elizabeth Ortiz